

## REMARKS

Reconsideration of the subject application in view of the present amendment is respectfully requested.

By the present amendment, claim 3 has been canceled. Claims 1 and 4 have been amended.

Based on the foregoing amendments and the following remarks, the application is deemed to be in condition for allowance, and Action to that end is respectfully requested.

The Examiner rejected claims 1 and 2 under 35 U.S.C. § 103(a) as being unpatentable over Ohtomo, U.S. Patent No. 6,396,571 (Ohtomo) in view of Win, U.S. Patent No. 4,730,190 (Win). Claims 3 and 4 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ohtomo and Win and further in view of Dowsett, U.S. Patent No. 4,766,418 (Dowsett). It is respectfully submitted that claims 1, 2, and 4 are patentable over the cited references.

Specifically, claim 1 now recites that the additional input means is logically OR connected with the associated input means for triggering the measuring operation.

The prior art does not disclose a portable measuring device with additional input means.

Neither Ohtomo nor Win discloses a logical OR connection of the additional input means with the associate input means, as recited in claim 1.

The Office Action asserts that it would be obvious to provide such connection in view of Dowsett. Applicant respectfully disagrees with this assertion.

Dowsett relates to a computer keyboard. The object of Dowsett is to allow a two-hand finger typing, i.e. to shift the lower-upper-function with one hand and type the letter-key with the other one.

The object of the present invention is to allow pressing of the start button only with one hand (at unfortunate measurement situations with a usually measurement device with only one start button both hands are needed – one to hold the device and the other to press the start key). That is why the logically OR connected start button is arranged on a side panel.

It is respectfully submitted that Dowsett is not a relevant reference.

In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if

not, then be reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992).

Dowsett, as discussed above, is not in the field of the applicant endeavor. Neither is Dowsett pertinent to a particular problem the present invention solves.

However, even with Dowsett being, *arguendo*, a pertinent reference, a *prima facie* case of obviousness has not been made.

Under MPEP § 2143 *prima facie* case of obviousness requires that three basic criteria be met.

First, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitation.

It is respectfully submitted that at least the first element of *prima facie* obviousness has not been established.

“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggesting supporting the combination. Under section 103, teachings of references can be combined only if there is some suggesting or incentive to do so.”

In re Fritch, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992 (footnote omitted) (emphasis in original)). See also In re Sernaker, 217 U.S.P.Q. 1,6 (Fed. Cir. 1983); SmithKline Diagnostics, Inc. v. Helena Laboratories Corp., 8 U.S.P.Q.2d 1468, 1475 (Fed. Cir. 1988); IU, 10 U.S.P.Q.2d 1397, 1399 (Fed. Cir. 1989); In re Fine, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

There is no suggestion, incentive or motivation in Dowsett and/or Ohtomo and/or Win for their combination.

A statement that it would have been obvious to one skilled in the art to make modifications to the references is not sufficient to establish a *prima facie* case of obviousness. MPEP § 2143.01 relying on Ex Parte Levengood, 28 U.S.P.Q.2d 130 (Bd. Pat. App. & Inter. 1993). In order to establish a *prima facie* case of obviousness, “it is necessary for the Examiner to present evidence,

preferably in the form of some teaching, suggesting incentive or inference in the prior art, or in the form of generally available knowledge, that one having ordinary skill in the art would have been led to combine the relevant teachings.” Id. At 1301 (emphasis in original). No such evidence is presented in the Office Action. It is noted that the case law rejects the “common knowledge” of one skilled in the art as a substitute for specific evidence that the prior art suggests the invalidating combination or references. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002).

The Federal Circuit has held that a claimed invention was not obvious, where “[c]onspicuously missing from [the] record is any evidence, other than the PTO’s speculation (if it be called evidence) that one skilled in the art would have been motivated to make the modification of the prior art “necessary to arrive at the claimed invention. *In re Jones* 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992).

The Court of Appeals for the Federal Court clearly stated:

It is impermissible to use the claimed invention as an instruction manual or template to piece together the teaching of the prior art so that the claimed invention is rendered obvious.

*In re Fritch*, 23 U.S.P.Q. 2d 1780, 23 1780, 1783 (Fed. Cir. 1992)

In the *In re Fritch* holding only confirmed a long established view that obviousness should not be read “into an invention on the basis of Applicant’s own statements”, that the prior art must be viewed “without reading into that art Appellant’s teachings”, and that those teachings of the prior should, “in and of themselves and without the benefits of Appellant’s disclosure (emphasis in the original text) make the invention as a whole, obviously.” *In re Sponnoble*, 160 U.S.P.Q. 237, 243 (CCPA 1969). It is respectfully submitted that the teachings of the prior art does not make the present invention obvious.

It is respectfully submitted that obviousness of the present invention over the combination of Ohtomo, Win and Dowsett can be gleaned only from a hindsight reconstruction.

The Court of Appeals for the Federal Circuit has consistently ruled that it is not permissible to use hindsight to reject a claim.

As pointed out in *Uniroyal v. Redkin-Willey*, 5 U.S.P.Q. 2d 1434, 1438 (Fed. Cir. 1988):

When prior art references require selective combination by the Court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. . . . Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination.

Nothing in the prior art suggests the desirability of the combination set forth in the Office Action. The same Court further stated:

... it is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention."

In view of the above, it is respectfully submitted that the combination of Ohtomo, Win and Dowsett does not make obvious the present invention, as defined in claim 1, and the present invention, as defined by claim 1 is patentable over said combination. Claims 2 and 4 depend on claim 1 and are likewise allowable.

## CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects, in order to place the case in condition for final allowance, then it is respectfully requested that such amendment or correction be carried out by Examiner's amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

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